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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/294,956	04/20/1999	INGEMAR J. COX	12558	6648
23389	7590	01/06/2005	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC			ZAND, KAMBIZ	
400 GARDEN CITY PLAZA			ART UNIT	
GARDEN CITY, NY 11530			PAPER NUMBER	
			2132	

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/294,956

Applicant(s)

COX ET AL.01

Examiner

Kambiz Zand

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 130-133 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 130-133 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 13 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. Claims 1-129 and 134 have been cancelled.
4. Claims 130-133 have been amended.
5. Claims 130-133 are pending.
6. Examiner withdraws objection to the drawings and specification due to correction by the applicant. Drawing submitted On 09/16/2004 has been approved by examiner.
7. Examiner withdraws rejection of claims 130-132 under 35 U.S.C 112-second paragraphs due to correction by the applicant.

### ***Response to Arguments***

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.
- In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. "a digital signature inserted into the digital data" & "inserting a public

key for a digital signature into predetermined bit portions of digital data” page 7, second and third paragraph of the response dated 09/13/2004) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The claims only disclose “inserting the received data into a predetermined bit portions..” and not what applicant asserts above.

#### ***Claim Rejections - 35 USC § 102***

9. **Claims 130-133** are rejected under 35 U.S.C. 102(e) as being anticipated by Ruppert et al. (5,640,002 A).

**As per claims 130 and 132** Mauratani et al (6,061,451 A) teach a method, a device for inserting data into digital data for subsequent authentication of the digital data, the device, method comprising the steps of:

Receiving data from a radio frequency transmission/antenna comprising a public key for a digital signature;

Means and method of inserting the received data into a predetermined bits portion of the digital data; and

Means and method for authenticating the digital data based on the received data (see abstract for disclosing receiving and transmitting by radio frequency (RF) through transceiver, a communication port, an audible feedback device, etc; fig. 41

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where block 749 discloses sending or receiving of public key, block 751 discloses digital data consisting of serial number and store id and insertion of public key as received data into bit portions that is the encrypted digital data (encrypting using public key), and block 753,757,759 for authentication based on the received data).

**As per claims 131 and 133** Mauratani et al (6,061,451 A) teach a method, a device for inserting data into digital data/image for subsequent authentication of the digital data/image, the device, method comprising the steps of:

A computer capable of accessing the Internet and receiving data comprising a public key for a digital signature from an Internet link ;

Means and method for inserting the data into the digital data/image; and

Means and method for authenticating the digital data/image based on the received data (see fig. 41 where block 749 discloses sending or receiving of public key, block 751 discloses digital data consisting of serial number and store id and insertion of public key as received data into bit portions that is the encrypted digital data (encrypting using public key), and block 753,757,759 for authentication based on the received data; col.47, lines 11-17 discloses the invention is capable of using Internet link using telecommunication secure channel; fig.3 block 46 disclose barcode scanner which represent digital image capturing capability).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 130-133** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mauratani et al (6,061,451 A) in view of Ruppert et al. (5,640,002 A).

**As per claims 130 and 132** Mauratani et al (6,061,451 A) teach a method, a device for inserting data into digital data for subsequent authentication of the digital data (see fig.1 where the authentication of inserted data digital data that has been received from a network in the form of scrambled data is being authenticated; col.6, lines 12-19 where the data is scrambled by scrambled circuit using an scrambled key, the key corresponds to the inserted data as also shown in col.5, lines 14-16) , the device comprising:

An antenna for receiving data from a radio frequency transmission (see col.5, lines 20-24 where the data network received may be received from an antenna that corresponds to a radio frequency that also have antenna transmission and receiver as an inherent part of its system);

Means for inserting the data into the digital data image (see col.5, lines 14-30; col.6, lines 13-20; col.7, lines 65-67; col.8, lines 1-27; also see image data such as mpeg in the entire reference; Also see col.5-28 where different embodiment using

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above methods and means of claims 130 and 132 are disclosed) but do not disclose explicitly receiving data comprising a public key and insertion of the received data into predetermined bits portions. However Ruppert et al. (5,640,002 A) disclose receiving data comprising a public key and insertion of the received data into predetermined bits portions (see fig. 41 where block 749 discloses sending or receiving of public key, block 751 discloses digital data consisting of serial number and store id and insertion of public key as received data into bit portions that is the encrypted digital data (encrypting using public key), and block 753,757,759 for authentication based on the received data). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Ruppert's public key insertion into digital data and authentication based on such insertion in order to authenticate the digital data in a secure fashion using public key crypto-system.

**As per claims 131 and 133** Mauratani et al (6,061,451 A) teach a method, a device for inserting data into a digital image for subsequent authentication of the digital image (see fig.1 where the authentication of inserted data digital data that has been received from a network in the form of scrambled data is being authenticated; col.6, lines 12-19 where the data is scrambled by scrambled circuit using an scrambled key, the key corresponds to the inserted data as also shown in col.5, lines 14-16), the device comprising:

A computer capable of accessing the Internet and receiving data from an Internet link (see col.8, lines 49-57; col.8, lines 58-63);

Means for inserting the data into the digital image(see col.5, lines 14-30; col.6, lines 13-20; col.7, lines 65-67; col.8, lines 1-27; also see image data such as mpeg in the entire reference; Also see col.5-28 where different embodiment using above methods and means of claims 131 and 133 are disclosed) but do not disclose explicitly receiving data comprising a public key and insertion of the received data into predetermined bits portions. However Ruppert et al. (5,640,002 A) disclose receiving data comprising a public key and insertion of the received data into predetermined bits portions (see fig. 41 where block 749 discloses sending or receiving of public key, block 751 discloses digital data consisting of serial number and store id and insertion of public key as received data into bit portions that is the encrypted digital data (encrypting using public key), and block 753,757,759 for authentication based on the received data). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Ruppert's public key insertion into digital data and authentication based on such insertion in order to authenticate the digital data in a secure fashion using public key crypto system.

### **Conclusion**

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see

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<http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kambiz Zand

12/20/04

  
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